

Attorney Docket No. SteffanE_P_1_03
Reply to Final Office action of January 25, 2005

Application No. 10/614,304

REMARKS/ARGUMENTS

In view of the above amendment and the following remarks, reconsideration of the outstanding Office Action is respectfully requested.

In the Specification, the Abstract has been amended according to Examiner's objection of the use of the term "means" in line 8 of the abstract. The term "members" now replaces the term "means".

Regarding statements in Office Action mailed 01/25/2005:

Examiner maintains that Applicant's arguments filed on 12.14.2004 are not persuasive in that Jamieson *et al.* discloses a bag that is stable in a vertical position while at rest (*i.e.*, while in a non-operative position).

Applicant respectfully calls Examiner's attention to the fact that Applicant clearly refers to a stable, vertical position for the bag/cart when "at rest" during the game (*i.e.*, while the bag/cart is in an operative position) while Jamieson *et al.* discloses a bag that is stable in a vertical position while in a non-operative position and then only when the bag portion is removed from the cart. Thus, Applicant maintains that the teachings of Jamieson *et al.* do not teach or anticipate Applicant's invention.

Moreover, Applicant respectfully requests Examiner to reassess his statement that the mounting members (70, 82) taught by Nordland are not biasing pins, in view of the definition given to a biasing member by the USPTO Classification Index (just below) and the expanded argument given below.

Class/Subclass 403/326 defines "**BIASED CATCH OR LATCH**" as a structure comprising means for securing two members together wherein an element biased into a recess or opening holds the members in assembled relation.

Thus, Applicant maintains that the teachings of Nordland do not teach or anticipate Applicant's invention.

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1. (Corresponds to O.A. No. 4) The alternative rejection of Claim 1 (as recited in Applicant's reply to first Office Action filed 12/14/2004) under 35 USC § 102(b) as being anticipated by Jamieson et al. (U.S. Patent No. 2,647,762) is respectfully traversed.

According to MPEP 706.02(b) a rejection based on 35 U.S.C. 102(b) can be overcome by persuasively arguing that the claims are patentably distinguishable from the prior art. Therefore, as all the elements of the claim in question are not present in Jamieson et al. patent, the claim in question is not anticipated by Jamieson et al., and is, thus, patentably distinguishable from the art disclosed by Jamieson et al.

With respect to Claim 1, Claim 1 encompasses a:

"A foldable golf-bag transporting golf-cart/golf bag - assembly, comprising:

- a) a golf-bag;
- b) a foldable golf-cart, and

c) mounting means for securely, reversibly mounting said golf-bag on said golf-cart, where said mounting means provide for said bag to maintain a stable vertical position in a rest position free from the need to use mounting straps or biasing mounting members." [Emphasis added].

To reiterate: Applicant's claims a golf-bag/golf-cart assembly mounting means that provides for said bag to maintain a stable vertical position in a rest position free from the need to use mounting straps or biasing mounting members.

The meaning of "rest position" is clear from a reading of the specification as filed, as shown in the relevant paragraphs, copies of which are given below.

[0008] Another shortcoming of the hand-carts presently in use is experienced when a golfer places the golf-cart with its attached golf-bag in a rest position at a particular hole. In order for this type of cart and bag to be stable while standing upright, the cart and bag must be placed in a position that results in the bag and cart being at some angle less than ninety degrees to the ground surface. This means that the golf clubs in the golf-bag must lean one upon another making underlying clubs difficult to identify and to retrieve. There are some golf-bag carts that hold the golf-bag in a more vertical position, but these bags are structurally unstable and likely to fall over. Thus, clearly, there is a need for a transporting hand-cart and golf-bag assembly that can maintain a stable, vertical, resting position so that a golfer can easily identify the required

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club and easily retrieve it from the golf-bag without having to "dig in" under the overlying clubs and having to bend over to one side or another.

[0013] The present invention satisfies the urgent need in the art by providing for a mobile golf-bag and transport hand-cart having the means for a golfer to quickly and easily secure the golf-bag to the hand-cart without having to depend on twisting and folding straps and breakable buckles. Furthermore, the golf-bag/cart assembly, as taught herein, discloses a hand-cart assembly that allows the cart and the bag to stand stably in a vertical position so that a golfer can easily identify and retrieve the required club from the golf-bag without having to bend over to one side or another. The invention as taught herein also provides for a hand-cart frame that is lightweight and durable, conforms to the shape of today's golf-bags, is easily and rapidly folded and unfolded, once folded the cart is compact enough to fit into most any storage and transport space, is simple in its construction, and can be produced affordably. The golf-bag/cart assembly of the present invention provides a distinct advantage in that the cart's wheels are functional in both a spaced apart and a retracted position to provide for the added feature of being able to easily wheel the cart with bag mounted through a narrow opening such as a doorway or gate. The present invention additionally makes available the means to retrofit an existing golf-bag to a golf-bag transport cart of this invention, i.e., one that allows the bag and cart to remain stable in a vertical at-rest position as well as when the cart and bag are being transported around the golf course, one that has a lightweight frame that conforms to the shape of golf-bags with rear pockets, is durable, has retractable telescoping wheels, is able to be folded compactly for transport and storage, and yet is durable and affordable.

[0031] FIG. 2b illustrates rest stop 28 supporting platform 18 to provide for golf-bag 1 to be supported in a vertical position while the cart is at rest, as is shown in FIG. 1. Maintaining golf-bag 1 in a vertical position while the cart is at rest allows for easy identification of a desired golf club, as well as for easy removal of the identified club from the cart.

From the specification as filed, it is abundantly clear that a "rest position" or "at rest" refers to the position of the bag/cart during the times that a player must free his hands from the cart so that the player may choose the requisite club, make the play, and return the club to the bag. Finding a particular club, removing the club from the bag, and returning the club to the bag are activities that are easier, quicker, and safer when the bag (on the cart) is able to maintain a vertical position. Thus, "at rest" clearly means "at rest" during play.

Thus, the specification, as filed, describes the need for a golf-bag/cart assembly that remains vertical while at "rest" at a particular hole and the fact that the present invention provides a solution for that need. The term "rest" clearly refers to the state of

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the bag/cart during a golf game, not before or after the game when the bag is kept in storage. As stated by Examiner, Jamison et al. teach a bag that may be kept in a vertical position while the bag is in a non-operative state (Final Office Action, Page 3, top of page). In fact, as understood by Applicant, the only time the reference cart may perhaps be stable in a vertical position is when the bag is removed from the cart for storage of each.

And, as Applicant stated in his response to the first office action:

Jamieson et al. does not teach a golf-bag carrier that maintains the golf club bag in a stable vertical position while at rest, for example while a golfer is golfing. It appears to Applicant that Jamieson et al. disclose a folding golf-bag carrier that, while at rest [during play] and supporting a golf-bag, maintains the bag at an inclined position. In fact, Figure 2 shows a golf-bag supported by the folding golf-bag carrier taught by Jamieson et al. in an at rest position. "The bottom of the frame member 10 is bent around as shown at 42 to form a portion which may rest on the ground when the device is in use to hold it in an upright position while the player is engaged in his game and leaves the device standing nearby."

Lines 53 – 57.

"Upright position" as used by Jamieson et al. does not mean a vertically upright position. It means, according to the drawing, that the bag is inclined from vertical about 45 degrees. As was stated in Applicant's application as filed, the bag holders that are known to Applicant all support a golf-bag in such an inclined position which can make the retrieval of a desired golf club from the bag difficult as the desired club might be under a number of other golf clubs that are leaning on top of the desired club. This arrangement also can make the bag unstable and apt to fall over onto the ground.

Applicant's invention, as originally claimed, solves this problem, among others, by providing for the cart to hold the bag vertically upright, that is so that the axis of the bag is perpendicular to the ground surface, while the cart is at rest allowing for easy identification and removal of a desired

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club from the bag, as well as holding the bag in a more stable upright position.

As it is well-settled that a reference cannot anticipate a claim unless that reference teaches and shows each and every recited feature of that claim, and as Jamieson et al. do not teach nor show, as is recited in Claim 1, a ". . . golf-cart/golf-bag assembly mounting means that provides for said bag to maintain a stable vertical position in a rest position free from the need to use mounting straps or biasing mounting members . . .", Applicant respectfully declares that independent Claim 1, for the reasons given above, to be patentable over the cited reference.

2. (Corresponds to O. A. No. 5) The rejection of Claims 1 -3, 6, 8, and 19 under 35 USC § 102(b) as being anticipated by Nordland (U.S. Patent No. 3,580,533) is respectfully traversed.

On page 7, last sentence of Response to Arguments, Examiner states that he disagrees with Applicant that Nordland teaches a golf cart mounting that requires a removable biasing pin, "because the mounting members (70, 82) that are not a biasing pin." Applicant agrees with Examiner that mounting members (70, 82) are not a biasing pin, but it is Applicant's understanding that pin 88, having pin head 90, fitting into passageway 84 biases, i.e., rigidly maintains, the position of stem portion 78 of projecting element 72 in its predetermined proper alignment with respect to the tubular frame (Col. 3, lines 43-47).

With respect to Claim 1, Claim 1 encompasses a:

A foldable golf-bag transporting golf-bag/golf-cart assembly, comprising:
a) a golf-bag;
b) a foldable golf-cart, and
c) mounting means for securely, reversibly mounting said golf-bag on said golf-cart, where said mounting means provide for said bag to maintain a stable vertical position in a rest position free from the need to use mounting straps or biasing mounting members. [Emphasis added].

It is Applicant's understanding that Nordland teaches a golf-cart mounting apparatus that requires a removable biasing pin.

Col. 3, lines 24-26:

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This stem portion 78 is designed to be inserted into an aperture 80 provided in a locking member 82 . . .

Col. 3, lines 31-38:

. . . a channel extending therefrom into which the stem portion 78 of the projecting element 72 can be inserted.

To provide for the removable securement of stem portion 78 from the channel formed in lock member 82, a generally vertical passage 84 is bored through locking member 82 substantially along the longitudinal axis of the tubular frame 12. The stem portion 78 is similarly provided with a vertical passage 86, having approximately the same diameter as passage 84 . . .

Col. 3, lines 31-38:

A pin 88 formed with an enlarged head portion 90 to facilitate gripping thereof, is inserted into aligned passages 84 and 86 and thereby rigidly maintains the position of stem 78 of projecting element 72 in its predetermined proper alignment with respect to the tubular frame of the golf cart.

A biasing means is well-known and accepted to be a means used to influence, predispose, or control the movement of a piece of machinery. Nordland's biasing pin "88" controls, as it "rigidly maintains" the stem portion of the mounting means of the golf-bag's projecting element 72 ". . . in its predetermined proper alignment . . ." on the mounting means of the cart frame so that the stem, and, thus, the bag, will not move away from and fall off of the cart frame.

In Paragraph [0034] of the Application as originally filed, Applicant teaches:

"FIG. 2e is an exploded view better illustrate bag-affixed upper mounting assembly member 34 having wedge-shaped coupling protrusion 34a that is complementary to mounting recess 32a of cart-affixed upper mounting assembly member 32. When member 34 is mounted together with member 32 upper mounting assembly 30 is formed (see FIG. 1). The mounting assembly of this embodiment provides for easy and quick mounting of bag to cart resulting in a tight, secure bag-to-cart connection in one simple movement. Instead of threading and tightening mounting straps or having to adjust fittings or biasing means, the bag is lifted only a few inches so that the bag-affixed mounting members are aligned over the cart-affixed mounting members and the bag is then dropped into position. To remove the bag from the cart, the golfer need only lift the bag up a few inches and the bag is released. The invention, as taught, provides for a mounting procedure that is much less tedious than the systems presently available. The mounting procedure, of this invention, takes only seconds, as does the dismounting procedure. Once mounted

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the sliding dovetail connection of this embodiment assures that the bag is securely positioned on the cart until the golfer deliberately dismounts the bag. Another benefit of this mounting assembly is that no tools are required. Additionally, the mounting assembly as taught herein is free from the need for biasing or otherwise moving parts, thus significantly reducing the possibility of breakage and the need to replace or repair broken or worn parts. It is obvious, therefore, that the invention disclosed herein has responded to the heretofore unmet need in the art for means to quickly, easily, and reversibly secure a golf-bag to a hand-cart [emphasis added].

It is clear then that Applicant teaches and claims, ". . . mounting means for securely, reversibly mounting said golf-bag on said golf-cart, where said mounting means provide for said bag to maintain a stable, vertical position in a rest position free from the need to use mounting straps or biasing mounting members." [emphasis added].

As it is well-settled that a reference cannot anticipate a claim unless that reference teaches and shows each and every recited feature of that claim, and as Nordland does not teach a ". . . golf-bag/golf-cart assembly mounting means that provides for said bag to maintain a stable vertical position in a rest position free from the need to use mounting straps or biasing mounting members . . ." as is claimed by Applicant, Applicant believes independent Claim 1, for the reasons given above, to be patentable over the cited reference.

Regarding Claim 2, Claim 2, besides depending on Claim 1 and thus being patentable for the reasons just presented, additionally recites:

". . . wherein the reversible mounting of the first and third mounting members onto the second and fourth members, respectively providing for secure, reversible mounting of said golf-bag on said golf-cart free from the need to use straps, a biasing mounting member, or moveable mounting parts" [emphasis added].

As Nordland does not teach mounting a golf-bag onto a golf-cart wherein the mounting is free from the need to use straps, a biasing mounting member, or moveable mounting parts, Nordland cannot be used to anticipate Claim 2, thus Applicant respectfully submits that Claim 2 is in condition for patenting.

Furthermore, regarding Claim 19, which recites the:

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"... secure, reversible mounting of said golf-bag on said golf-cart free from the need to use straps, a biasing mounting member, or moveable mounting parts" (emphasis added).

Nordland does not teach mounting a golf-bag onto a golf-cart wherein the mounting is free from the need to use straps, a biasing mounting member, or moveable mounting parts. Nordland cannot be used to anticipate Claim 19, thus Applicant respectfully submits that Claim 19 is in condition for patenting.

Regarding Claims 3, 6, and 8, which claims all depend indirectly from Claim 1 and directly from Claim 2 and therefore recite all of the limitations of the claims from which they depend, are also patentable, for the reasons given above.

3. (Corresponds to O.A. No. 7) The rejection of Claims 4 and 9 under 35 USC § 103(a) as being unpatentable over Nordland (U.S. Patent No. 3,580,533) as applied to Claim 2 above and further in view of Holtz (U.S. Patent No. 4,950,003) is respectfully traversed as Applicant respectfully contends that Examiner, for the reasons given below, has not established a *prima facie* case of obviousness.

Nordland has been shown to be an invalid reference which makes this rejection invalid. Notwithstanding, Holtz could not be used with Nordland to form a 103 obviousness argument for the following reasons.

Examiner states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the golf cart of Nordland with the addition of foldable platform as taught by Gregory (Holtz?).

However, it is well-accepted that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

The "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate."

The golf cart of Normandy is already designed to support a golf bag using loop member 62 which is rigidly connected to the bottom bag portion 56 and is positioned

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within a recess in 64 formed in T-shaped plate base member 66. It would be redundant to use the support taught by Holtz and thus would add unreasonably to the manufacturing and retail cost. Moreover, the design of Nordland would not accommodate the presence of supporting device "foldable platform section 14" taught by Holtz as a support device such as taught by Holtz would not be able to close as taught by Holtz if the support device were fitted to the device of Nordland because due to the presence of Nordland's plate 66.

Thus, the teachings of the references are not sufficient to render the claims *prima facie* obvious.

4. (Corresponds to O.A. No. 8) The rejection of Claim 7 under 35 USC §103(a) as being unpatentable over Nordland (U.S. Patent No. 3,580,533) as applied to Claim 2 above and further in view of Kao *et al.* (U.S. Patent No. 5,829,585) is respectfully traversed as Applicant respectfully contends that Examiner, for the reasons given below, has not established a *prima facie* case of obviousness.

Nordland was shown above to be an invalid reference which makes this rejection invalid. Notwithstanding, Kao could not be used with Nordland to form a 103 obviousness argument for the following reasons.

Kao, unlike Applicant teaches wheels that are able to be collapsed, but only when the device is collapsed. This is very different from Applicant's device where the wheels may be telescoped in or out while the cart is actively in use, that is, while the cart is being wheeled. So, if someone wishes to wheel the cart through a doorway, such as when exiting a clubhouse to go outdoors to the green, the wheels may be telescoped in so that the cart will fit through the doorway as is recited in Claims 7 and 15. Once outside the wheels may be telescoped out to improve balance of the device. In short, the collapsing of Kao's wheels is dependent on the closing of the golf-cart, while the wheels of Applicant's device are independent of opening or closing of the device.

Therefore, it is respectfully submitted that a *prima facie* obviousness of the claimed invention has not been established and that Claim 7 is, thus, patentable.

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5. (Corresponds to O.A. No. 9) The rejection of Claim 10 under 35 USC § 103(a) as being unpatentable over Nordland (U.S. Patent No. 3,580,533) as applied to Claim 3 above and further in view of Kao *et al.* (U.S. Patent No. 5,829,585) (should be Weis No. 6,186,522) is respectfully traversed as Applicant respectfully contends that Examiner, for the reasons given below, has not established a *prima facie* case of obviousness.

Claim 10 indirectly depends from both Claim 1 and Claim 2 and as it was shown above that Nordland does not teach all of the limitations claimed by Applicant in Claim 1 and Claim 2, and as, according to MPEP 2143, the prior art reference must teach or suggest all of the claimed limitations it follows that dependent Claim 10 is nonobvious under 35 U.S.C. 103 and thus, patentable.

Nevertheless, the handle 38 of Weis is centered with respect to the back of the bag and is parallel to the axis of the bag and thus, would be impossible to use in combination with Nordland, as the handle is designed to open and close along the line of Nordland's part 12, which would be impossible. If Weis's handle 38 conceivable were to be somehow incorporated into Applications design, it would significantly decrease the balance and the push-power of the handle of Applicant's invention. Moreover, the spreader brace as taught by Weis would also be inoperable if used in combination with Nordland's device.

6. Examiner has acknowledged that Claims 11 - 18 are directed to allowable subject matter.

7. Examiner has objected to Claims 5 and 20 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant respectfully asserts that as argued above Claims 1, 2, and 19 are patentable, thus it follows that Claims 5 and 20, that directly or indirectly depend from Claims 1, 2, and 19 are also in condition for allowance. However, Applicant has amended objected to Claims 5 and 20 according to Examiner's comments in the event Examiner will still not accept Applicant's solid reasoning.

8. The prior art made of record and not relied on is as cited and has been considered.

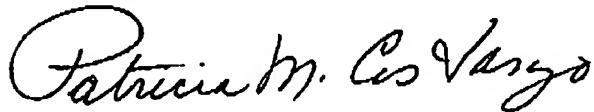
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CONCLUSION

In view of the above amendments (which are based on Examiner's objections if Claim 5 and Claim 20 and to make claim language consistent throughout each claim) and related arguments, the Applicant believes that the application is now in condition for allowance. Accordingly, favorable reconsideration and early passage to issue of the present Application are most respectfully requested.

Respectfully submitted,



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